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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,470	12/11/2006	Matthias Schwarz	285216US0PCT	6618
22850	7590	05/12/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
FINN, MEGHAN R				
ART UNIT		PAPER NUMBER		
1614				
NOTIFICATION DATE		DELIVERY MODE		
05/12/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/571,470

**Applicant(s)**

SCHWARZ ET AL.

**Examiner**

MEGHAN FINN

**Art Unit**

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 15-17, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-12 is/are rejected.
- 7) ☒ Claim(s) 8 and 13-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' arguments, filed February 09, 2009, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 15-17 and 19-20 remain withdrawn and thus claims 1-14 are currently pending examination.

The search was expanded beyond the elected species in response to applicant's arguments, thus necessitating the new rejection.

#### ***Claim Objections***

Claims 8, 13, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-6 recites the limitation "R5" and "R6" in "according to claim 1, wherein R5" however there is no R5 or R6 in claim 1. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4, 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gotteland et al. (US 2005/0119277 A1).

In claim 1, applicant claims a benzimidazole acetonitrile compound according to formula I. Gotteland et al. teaches the same generic formula (abstract) and there is significant overlap in the X, G, R1 and R2 groups (page 4, [0048-0057]). Specifically Gotteland et al. teaches compounds that are encompassed by claim 1, such as the

compound shown in step 4 of example 1 (page 10, [0196]). This compound has R1 and R2 being H, G is a pyrimidinyl group with an L group containing at least one heteroatom. Further they specifically teach G being a pyrimidinyl with an L group that can be an amino, or a 3-8 membered cycloalkyl containing a heteroatom (page 5, [0061-0062]). Thus claim 1 is anticipated by Gotteland et al.

For claim 2, applicant claims that R1 is H, which is clearly taught by Gotteland et al. in example 1 as noted above and as an option in the generic formula (page 4, [0054]). Thus claim 2 is also anticipated by Gotteland et al.

In claim 4, applicant claims compounds having a formula of claim 1, with the G being a pyrimidinyl group being added to the formula. As discussed above, the compounds of Gotteland et al. anticipate this formula and thus claim 4 is anticipated by Gotteland et al.

In claims 9-11, applicant claims the compound is for the preparation of a medicament, including diabetes. The intended use of the compounds does not carry patentable weight and the same compound could be used for the same purposes, thus claims 9-11 anticipated by Gotteland et al. for the reasons discussed above.

In claim 12, applicant claims that the compound of claim 1 has a pharmaceutically acceptable carrier, diluent or excipient. Gotteland et al. teach the use of these compounds for treatment of scleroderma and teach capsules containing a starch diluent (page 12, example 6, [00237]) which contains both a pharmaceutically acceptable carrier and a diluent. Thus claim 12 is also anticipated by Gotteland et al.

The above claims are anticipated by Gotteland et al., however they are alternatively obvious over Gotteland et al. who teach the same generic formula with mostly the same R1, R2, and G groups (page 4, [0048-0058]) and many of the compounds in applicants claims are clearly within the scope and teachings of Gotteland et al. Thus alternatively claims 1-2, 4, and 9-12 are unpatentable over Gotteland et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gotteland et al. (US 2005/0119277 A1).

In claim 3, applicant claims R2 is a C1-C3 alkyl. In the preferred embodiments of Gotteland et al. R2 is a hydrogen, however Gotteland et al. clearly teach that R3 can be a C1-C6 alkyl (page 4, [0058]) and thus it would be obvious to one of ordinary skill in the art at the time of the invention that R2 being a C1-C3 alkyl is obvious in light of the teachings of Gotteland et al. and thus claim 3 is unpatentable over Gotteland et al.

In claims 5-6 applicant claims that R5 is hydrogen and R6 is hydrogen (claim 5), R6 is a C1-C6 alkyl (claim 6). As discussed above, there is no actual R5 or R6 in claim 1, however assuming that R5 and R6 are supposed to be part of L being NR5R6 (as claimed in claim 4), Gotteland et al. also teaches amino groups for L and substituted amino groups (page 5, [0062]) and thus claims 5-6 are unpatentable over Gotteland et al.

In claim 7 applicant claims that L is an acylamino moiety of NR5C(O)R6 where R5 and R6 can both be hydrogen. Gotteland et al. teaches aminoacyl groups and aminocarbonyl groups (page 5, [0062]) and thus claim 7 is also unpatentable over Gotteland et al.

### ***Conclusion***

No claims are allowed. Claims 8, 13, and 14 are free of the prior art.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meghan Finn whose telephone number is (571) 270-3281. The examiner can normally be reached on 9:30am-7pm Mon-Thu, 9:30am-6pm Friday (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Meghan Finn

/James D Anderson/  
Examiner, Art Unit 1614



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